

REMARKS

Claims 1-6, 12-14, 22 and 23 are pending. By this Amendment, claims 1 and 3 are amended. No new matter is added. Reconsideration of the application is respectfully requested.

Applicants appreciate the courtesies shown to Applicants' representatives by Examiner Patterson in the December 7, 2006 personal interview. Applicants' separate record of the substance of the interview is incorporated into the following remarks.

I. Full Review By Supervisory Patent Examiner Is Requested

In accordance with MPEP §707.02, because this application has been pending for more than five years and because there have been more than three Office Actions, a careful and thorough review by the Supervisory Patent Examiner is respectfully requested, and it is respectfully requested that the Patent Office make every effort to conclude the prosecution of this application. As stated in this section of the MPEP, this application should be considered "special" by the Patent Office.

Applicants respectfully request acknowledgment that the Supervisory Patent Examiner has reviewed the prosecution of this application.

II. Formal Matter

The Office Action objects to the amendment filed July 21, 2006 because it introduces new matter into the disclosure, and rejects claims 24 and 25 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully disagree. Nevertheless, as discussed during the interview, the objection and the rejection are moot because claims 24 and 25 are canceled. Therefore, withdrawal of the objection and the rejection is respectfully requested.

III. The Pending Claims Define Patentable Subject Matter

The Office Action rejects claims 1, 2, 22 and 24 under 35 U.S.C. §102(b) over U.S. Patent No. 5,193,711 to Hirata et al. (Hirata). The rejection of canceled claim 24 is moot. The rejection of the remaining claims is respectfully traversed.

Claim 1 recites, *inter alia*, that a cylindrical molded body includes upper and lower end portions that each define an opening. Support for these features are found, at least, in Figs. 1-7. That is, as shown in Fig. 4, an insert 32 is set in a mold unit 13 by raising a core 16 into the mold unit 13. Then, as shown in Fig. 5, a molten resin is then injected from gate holes 19 and flown into the space between the mold unit 13 and the core 16 while applying pressure towards the insert 32. After cooling the mold, the hardened cylindrical molded body is created. As discussed during the interview, because of the core 16, which is inserted into the space of the mold unit 13 as shown in Fig. 4, the cylindrical molded body is tubular. In other words, as discussed during the interview, the cylindrical molded body has upper and lower ends each defining an opening. Thus, the specification and figures provide adequate support for the claimed features.

The claims must be understood in light of the disclosure in the specification. As discussed at MPEP §2163.02, the subject matter of the claim need not be described literally in order for the disclosure to satisfy the written description requirement. The claimed invention can be described using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). As discussed at MPEP §2163(I)(B), the features recited in the claims can be supported explicitly, implicitly or inherently by the disclosure. Therefore, the above identified claim features are properly and clearly supported by the specification.

As discussed and agreed to during the interview, Hirata discloses at Fig. 5(B), for example, a molded container having a bottom portion that is closed.

Furthermore, as discussed during the interview, claim 1 recites that a mark is produced by injection of body forming material from an injection gate opening positioned on the inner surface of the sidewall portion. Claim 1 further recites that the mark is positioned, as a result of the injection, at the inner surface of the cylindrical molded body between upper and lower edges of the insert so as to be at a position corresponding to a position on the inner surface that is covered by the insert.

The Office Action alleges that Hirata's thickened area of a container 1, shown in Fig. 13 of Hirata, corresponds to the recited mark. This allegation is improper because the Office Action's interpretation of the claimed term is not based on any recitation but is merely arbitrary. As discussed above, the mark of claim 1 is produced by injection of body forming material from an injection gate opening positioned on the inner surface of the sidewall portion of the cylindrical molded body. Moreover, as discussed above, the claimed terms must be interpreted in light of the disclosure in the specification. As clearly described in Applicants' specification, the "mark" recited in the claims is a mark made by the injection of a molten resin from an injection gate opening. See page 17, lines 12-14 of the present specification. Therefore, the Office Action's apparently arbitrary interpretation that the "mark" is a thickened part of a part of the container 1 is improper.

Hirata nowhere teaches this feature. As discussed in the July 21, 2006 Amendment, Hirata teaches that the injection is made on the bottom wall. See col. 3, lines 7-11 of Hirata, which discloses that how injected resin flows is indicated by arrows. Clearly shown in Fig. 2(A), the injection is made at the center of the bottom section 5 of the label 7. Therefore, although not specifically discussed, Hirata teaches that the injection mark produced by injection of resin from an injection gate would be, if at all, on the bottom wall of the container

1. Therefore, Hirata does not teach or suggest each and every feature of claim 1.

Accordingly, claim 1 is patentable over Hirata.

Claims 2 and 22 are allowable for their dependence on claim 1, as well as for the additional features they recite. For example, claim 22 recites that the mark is positioned only at the inner surface of the sidewall portion while being closer to the upper edge than the lower edge of the insert in an axial direction of the cylindrical article, and only at a position corresponding to a position on the inner surface that is covered by the insert. As discussed above, the Patent Office's interpretation of the recited "mark" is incorrect, and Hirata's mark would be on the bottom wall, not on the sidewall portion of the container 1. Thus, Hirata does not teach or suggest the features recited in claim 22.

At least for these reasons, Applicants respectfully request withdrawal of the rejection.

The Office Action rejects claims 3-6, 12-14, 23 and 25 under 35 U.S.C. §103(a) over Hirata in view of Japanese Patent No. 6246777 to Suzuki et al. (Suzuki) and Japanese Patent No. 03286815 to Asahi Chemical (Asahi). This rejection is moot with respect to canceled claim 25, and is respectfully traversed with respect to the remaining claims.

Claim 3 recites, *inter alia*, curing and forming the cylindrical molded body while pushing the insert against the inner surface of the outer molding unit with the molten resin, the upper and lower end portions of the cylindrical molded body each defining an opening. Similar to the above arguments with respect to claim 1, Hirata does not teach or suggest these features.

Moreover, as discussed above, Hirata does not teach or suggest that a mark is produced by injection of molten resin from an injection gate opening, as recited in claim 3. Thus, Hirata does not teach or suggest the features of claim 3.

As discussed during the interview, Suzuki is applied for a pull-out mold unit. Suzuki discloses at paragraph [0018] (see an English translation of Suzuki submitted with the March

1, 2005 Appeal Brief) and Figs. 2-4 that the resin is injected at the mouth portion of Suzuki's container, which is not covered by an insert, and that the blank plate 103 has a pillar portion 102a through which an injected molten resin flows. That is, as discussed during the interview, the blank plate 103 forms an outside surface of the container 100, and thus, no molten resin is injected and flown behind the container 100. Thus, Suzuki does not teach or suggest that the molded body is cylindrical (i.e., tubular) or that an injection mark left by the injection gate is covered by the insert. Suzuki also fails to teach or suggest injecting a molten resin through an injection gate opening toward a molded body inner surface of a sidewall portion, at a position between upper and lower edges of the insert, so as to be at a position corresponding to a position on the molded body inner surface that is covered by the insert, as recited in claim 3.

Asahi is only applied for the teaching of a specific material used for the molten resin.

Therefore, at least for these reasons, Hirata, Suzuki and Asahi, alone or in combination, do not teach or suggest the features of claim 3.

Furthermore, at Page 8 of the Office Action, in response to Applicants' arguments that Suzuki would destroy the principle of Hirata because the bottom of Suzuki is attached after it is molded, the Office Action states that Suzuki is cited only for the teaching that it is well-known in the art to use a mold which is a pull out mold in the making of a container. However, Applicants respectfully submit that such an allegedly well-known technique cannot necessarily be used in any and every situation. That is, Hirata does not teach or suggest the use of a type of the mold unit taught by Suzuki. Because Suzuki uses an ejection pin 33 that pushes the resin 61 from the bottom as shown in Fig. 8, the molded container cannot have a bottom wall as taught by Suzuki.

As specifically discussed at MPEP §2141.02(VI), the prior art must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.

W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Suzuki specifically teaches that a bottom wall is separately provided and attached to the container 1, as shown in Fig. 3. Thus, in order for one to adapt the teaching of Suzuki into the subject matter disclosed by Hirata, the container of Hirata must be modified so that the bottom wall of Hirata must be removed or a hole must be made to allow an ejection pin 33 of Suzuki to run through.

However, such a modification would alter the principle of operation of Hirata because Hirata specifically discloses to provide a label 7 having a bottom section 5 and to inject molten resin from a position on the bottom section 5, as shown in Fig. 2(A) of Hirata, as discussed above. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Thus, one of ordinary skill in the art would not have been motivated to modify Hirata based on Suzuki, as suggested by the Office Action.

In addition, as clearly stated at MPEP §2143.01(III), the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Neither Hirata nor Suzuki teaches or suggests the desirability to combine each other. Thus, the Patent Office has not met the basic requirements to establish a *prima facie* case of obviousness, as clearly stated at MPEP §2143.

Furthermore, because neither Hirata nor Suzuki teaches or suggests the desirability to combine each other, the combination of Hirata and Suzuki must be based on impermissible hindsight knowledge gained from Applicants' disclosure. This is improper.

At least for these reasons, Applicants respectfully submit that Hirata and Suzuki are not combinable. Therefore, claim 3 is patentable over Hirata, Suzuki and Asahi.

Claims 4-6, 12-14 and 23 are allowable for their dependence on claim 3, as well as for the additional features they recite. In particular, claim 23 recites features similar to claim 22. As discussed above, Hirata does not teach or suggest these features. Neither Suzuki nor Asahi overcomes the deficiency of Hirata. Thus, none of the applied references teach or suggest the subject matter recited in claim 23.

At least for these reasons, withdrawal of the rejection is respectfully requested.

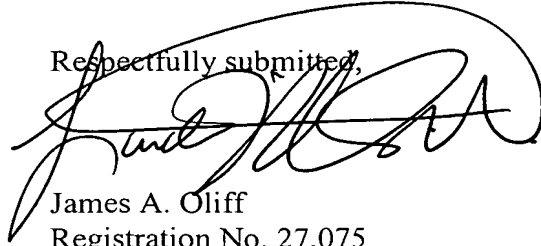
As discussed during the interview, new claims 26 and 27 recite that the insert is bonded to an entire surface of said outer surface of said sidewall portion, excluding a mouth portion of the cylindrical molded body. None of the applied references teaches or suggest this feature. Support for this feature is found in the specification at, for example, page 17, lines 9-11. Thus, claims 26 and 27 are allowable at least for their dependence on claims 1 and 3, respectively.

As discussed during the interview, new independent claim 28 recites an insertion-molded cylindrical article made by an insertion injection molding mold using a method similar to that recited in claim 3. As discussed above, none of the applied references, alone or in combination, teaches the features recited in claim 28. Thus, claim 28 is patentable over the applied references.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Date: December 19, 2006

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